

REMARKS

In the Office Action, the Examiner rejected claims 53, 55, and 59-61 under 35 U.S.C. §§ 101 and 112, first paragraph, as being allegedly not supported by either a specific and substantial asserted utility or a well established utility; rejected claims 34-52 and 59-64 as being unpatentable over U.S. Patent No. 6,853,713 to Fobert et al. ("Fobert"), in view of U.S. Patent No. 6,687,362 to Lindquist et al. ("Lindquist"), and further in view of U.S. Patent Application Publication No. 2004/0052356 of McKinzie et al. ("McKinzie"); and allowed claims 1-4, 6-8, 56, and 58.¹ Applicants wish to thank the Examiner for the indication of allowable subject matter.

By this Reply, Applicants have canceled claims 49 and 50 without prejudice or disclaimer, and amended claims 34, 59, and 62 to incorporate subject matter similar to that recited in canceled claims 49 and 50. Claims 1-4, 6-8, 34-48, 51-53, 55, 56, and 58-64 are currently pending with claims 1, 34, 53, 56, 59, and 62 being independent. Claims 5, 9-33, 54, and 57 were previously canceled without prejudice or disclaimer. Based on the foregoing amendments and the following remarks, Applicants respectfully request reconsideration and withdrawal of the claim rejections.

I. The §§ 101 and 112, First Paragraph, Rejections of Claims 53, 55, and 59-61

The Examiner rejected claims 53, 55, and 59-61 under 35 U.S.C. §§ 101 and 112, first paragraph, because "Applicant's specification does not recite adequate nor

¹ As Applicants' remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicants' silence as to assertions by the Examiner in the Office Action or certain requirements that may be applicable to the rejections (e.g., whether a reference constitutes prior art, ability to combine references, assertions as to patentability of dependent claims) is not a concession by Applicants that such assertions are accurate or such requirements have been met, and Applicants reserve the right to analyze and dispute such in the future.

enabling disclosure, as to 'computer-readable storage medium.'" Office Action at 2-3.

The Examiner asserted that "Applicant's specification supports only a statutory/hardware system/method with only a brief mention that such hardware/system/method can be or may be performed or substituted by various combinations of software and hardware without any adequate and enabling disclosure."

Id.

Applicants submit that the Examiner's assertion and the §§ 101 and 112, first paragraph, rejections are based on incomplete reading of the specification. The specification at, for example, FIG. 2 and page 11, line 17 - page 12, line 22, describes Memory 202 and Storage Module 204. More specifically, the specification provides that "[s]torage module 204 may be implemented with a variety of components or subsystems including, for example, a hard drive, an optical drive, CD ROM drive, DVD drive, a general-purpose storage device, a removable storage device, and/or other devices capable of storing information." Specification, at page 12, lines 4-7. Therefore, the specification provides adequate and enabling disclosure, and one of ordinary skill in the art, in view of the disclosure in the specification, would know how to use the claimed invention. Accordingly, Applicants respectfully request reconsideration and withdrawal of the §§ 101 and 112, first paragraph, rejections of claims 53, 55, and 59-61.

II. The § 103(a) Rejection of Claims 34-52 and 59-64

Applicants respectfully traverse the § 103(a) rejection of claims 34-52 and 59-64 over Fober in view of Lindquist, and further in view of McKinzie. A *prima facie* case of obviousness has not been established with respect to claims 34-52 and 59-64.

Amended independent claim 34 recites, among other things, "generating a query to determine whether to update the address book, prior to updating the address book" and "periodically updating the contact-related information stored in the address book based on an affirmative response to the query, independently of communications between the user and the party." Fobert, Lindquist, and McKinzie, taken alone or in combination, do not teach or suggest at least these features of amended independent claim 34.

With respect to canceled claims 49 and 50, the subject matter of which has been incorporated into amended independent claim 34, the Examiner asserted that "Fobert discloses . . . automatically updating the address book without user intervention (See col. 7 lines 16-26)." Office Action at 5. Fobert discloses, however, that "user can choose to update address book database 21 [and i]f the user chooses to update address book 21, client terminal controller 18 downloads the new information into address book database 21 as described in block 60." Fobert, col. 7, lines 16-23. Thus, the network of Fobert does not "generat[e] a query to determine whether to update the address book, prior to updating the address book" and "periodically updat[e] the contact-related information stored in the address book based on an affirmative response to the query, independently of communications between the user and the party," as recited in amended independent claim 34.

Lindquist does not teach or suggest "generating a query to determine whether to update the address book, prior to updating the address book" and "periodically updating the contact-related information stored in the address book based on an affirmative response to the query, independently of communications between the user and the

party," as recited in amended independent claim 34, and the Office Action does not dispute otherwise as Lindquist is not relied upon for any features recited in the claim. See Office Action at 3-4. Therefore, Lindquist fails to cure the deficiencies of Fobert.

McKinzie discloses that "[e]ntries and individual addresses of each entry may be linked to a profile of a trusted communications partner and automatically updated when the trusted communications partner updates their profile information." McKinzie, ¶ 39. McKinzie does not teach or suggest "generating a query to determine whether to update the address book, prior to updating the address book" and "periodically updating the contact-related information stored in the address book based on an affirmative response to the query, independently of communications between the user and the party," as recited in amended independent claim 34.

In view of the above-noted deficiencies of Fobert, Lindquist, and McKinzie, the Office action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and claim 34. Also, in view of those deficiencies, no combination of the applied references can possibly yield claim 34. Nor is claim 34 predictable from the applied references. Further, in view of those deficiencies, one of ordinary skill in the art would not have been motivated to modify the teachings of the references to achieve Applicants' claimed combinations. Thus, the Office Action has failed to clearly articulate a reason why claim 34 would have been obvious to one of ordinary skill in the art in view of the prior art. Accordingly, a *prima facie* case of obviousness has not been established with respect to claim 34, and the rejection under 35 U.S.C. § 103(a) should be withdrawn.

Amended independent claims 59 and 62, although of different scope, recite features that are similar to those discussed above with respect to amended independent claim 34. For reasons similar to those reasons set forth above with respect to amended independent claim 34, a *prima facie* case of obviousness has not been established with respect to claims 59 and 62, and the rejection under 35 U.S.C. § 103(a) should be withdrawn.

Dependent claims 35-48, 51 and 52 recite from independent claim 34, and dependent claims 60-61 and 63-64 depend from independent claims 59, and 62, respectively. Because any claim that depends from a nonobvious claim is also nonobvious, Applicants request the withdrawal of the § 103(a) rejection of claims 35-48, 51, 52, 60, 61, 63, and 64 at least by virtue of their dependence from claims 34, 59, or 62.

III. Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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